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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/717,513

Applicant(s)

JAKOBSSON, BJORN MARKUS

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. In view of the Appeal Brief filed on 09/07/2004, PROSECUTION IS HEREBY REOPENED. Applicant's arguments with respect to claims 1 – 25 have been considered but are moot in view of the new ground(s) of rejection as set forth below.

### ***Claim Rejections - 35 USC § 112***

2. Claim 23 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. "the portable device is a PCMCIA card which incorporates a Bluetooth transmitter and the first device is a PCMCIA port". The specification does not explain how a "portable device is a" PCMCIA card or the specification does not explain how the first device "is a" PCMCIA port.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 3, 14 – 17, 19 – 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Southerland (U.S. Patent Number 6,292,898, hereafter “Southerland”) in view of Varadharajan et al. (U.S. Patent Number 5,887,063, hereafter “Varadharajan”).

4. Regarding Claims 1 and 25, Southerland discloses  
placing a first device in an enclosure (Southerland Column 11 lines 8 – 28);  
placing a second device in the enclosure (Southerland Column 11 lines 8 – 28);  
sealing the enclosure while the first device and the second device are in the enclosure (Southerland Column 11 lines 8 – 28).

Southerland discloses that the first and second devices are interconnected (Southerland Column 11 lines 8 – 28), Southerland does not explicitly disclose that the first device to exchange a key with the second device while the first device and the second device are in the enclosure and while the enclosure is sealed, removing the first device and the second device from the enclosure after the key exchange; and using the

key to allow the first device and the second device to communicate with each other using methods of encryption outside the enclosure. However, Varadharajan discloses a first device to exchange a key with the second device, removing the first device and the second device from the enclosure after the key exchange; and using the key to allow the first device and the second device to communicate with each other using methods of encryption (Varadharajan Column 2 line 33 – Column 3 line 4 and Column 5 lines 4 – 16).

5. Motivation to combine the invention of Southerland with Varadharajan's teachings comes from the need for securing transactions sent between the first and the second device. Southerland provide a discussion for the need of security but silent as to the specific details of the technological key exchange involved; see Southerland Column 1 lines 12 – 28 and Column 7 line 57 – Column 8 line 19). It would have been obvious to one having ordinary skill in the art at the time the invention to combine Southerland's with Varadharajan because security is needed for the key exchange of Varadharajan and because Southerland provides details of secure and sealed enclosure to interconnect two devices. Southerland could have been modified by Varadharajan to arrive at the claimed invention by having the first and the second devices in the secure enclosure and logically exchanging a key to communicate with each other outside the secure environment.

6. Regarding Claim 14, Sutherland discloses

placing a first device into an enclosure (Southerland Column 11 lines 8 – 28);  
connecting the first device to a transmitter, wherein the transmitter is connected to a first end of a cord device the first end of the cord device being inside the enclosure (Southerland Column 11 lines 8 – 28). Southerland discloses the cord device has a second end which is interconnected to the second device (Southerland Column 11 lines 8 – 28), Southerland does not explicitly disclose the cord device has a second end which is outside the enclosure; and wherein the method further is comprised of connecting a second device, which lies outside the enclosure, to the second end of the cord device; and after connecting the first device to the first end of the cord device and after connecting the second device to the second end of the cord device, causing the first device to exchange a key with the second device while the first device is in the sealed enclosure; removing the first device from the enclosure after the key exchange; and using the key to allow the first device and the second device to communicate with each other using methods of encryption with the first device outside of the enclosure. However, Varadharajan discloses a first device to exchange a key with a second (cord) device wherein disclose the cord device has a second end which is outside the enclosure; and wherein the method further is comprised of connecting a second device, which lies outside the enclosure, to the second end of the cord device; and after connecting the first device to the first end of the cord device and after connecting the second device to the second end of the cord device, causing the first device to exchange a key with the second device while the first device is in the sealed enclosure;

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removing the first device from the enclosure after the key exchange; and using the key to allow the first device and the second device to communicate with each other using methods of encryption with the first device outside of the enclosure. (Varadharajan Column 2 line 33 – Column 3 line 4 and Column 5 lines 4 – 16).

7. Motivation to combine the invention of Southerland with Varadharajan's teachings comes from the need for securing transactions sent between the first and the second device. Southerland provide a discussion for the need of security but silent as to the specific details of the technological key exchange involved; see Southerland Column 1 lines 12 – 28 and Column 7 line 57 – Column 8 line 19). It would have been obvious to one having ordinary skill in the art at the time the invention to combine Southerland's with Varadharajan because security is needed for the key exchange of Varadharajan and because Southerland provides details of secure and sealed enclosure to interconnect two devices. Southerland could have been modified by Varadharajan to arrive at the claimed invention by having the first and the second devices in the secure enclosure and logically exchanging a key to communicate with each other outside the secure environment.

8. Regarding Claim 19, Sutherland discloses means for causing a first device to exchange a key (interconnected to accomplish desired functionality) with a second device (Southerland Column 11 lines 8 – 28);

means for preventing a third device from determining a key which is exchanged between the first device and the second device (Southerland Column 7 line 43 – Column 8 line 19), and

wherein the means for preventing the third device from determining the key is comprised of an enclosure having a filtering material (Southerland Column 7 line 43 – Column 8 line 19 and Column 11 lines 8 – 28);

wherein the enclosure is adapted to that it can completely surrounded both the first device and the second device in order to prevent the third device from determining the key (Southerland Column 7 line 43 – Column 8 line 19 and Column 11 lines 8 – 28).

Southerland does not explicitly disclose that the first device to exchange a key with the second device. However, Varadharajan discloses a first device to exchange a key with the second device (Varadharajan Column 2 line 33 – Column 3 line 4 and Column 5 lines 4 – 16).

9. Motivation to combine the invention of Southerland with Varadharajan's teachings comes from the need for securing transactions sent between the first and the second device. Southerland provide a discussion for the need of security but silent as to the specific details of the technological key exchange involved; see Southerland Column 1 lines 12 – 28 and Column 7 line 57 – Column 8 line 19). It would have been obvious to one having ordinary skill in the art at the time the invention to combine Southerland's with Varadharajan because security is needed for the key exchange of Varadharajan and because Southerland provides details of first and second device in an



enclosure to interconnect two devices. Southerland could have been modified by Varadharajan to arrive at the claimed invention by having the first and the second devices in the enclosure and logically exchanging a key to communicate with each other and to prevent a third device from detecting the key.

**10.** Claim 2 is rejected as applied above in rejecting Claim 1. Furthermore, Varadharajan discloses using the key to allow the first device and the second device to communicate with each other using methods of authentication outside the enclosure (Varadharajan Column 2 lines 19 – 28 and Column 3 lines 16 – 37).

**11.** Claim 3 is rejected as applied above in rejecting Claim 1. Furthermore, Southerland discloses

the first device is electronic (Southerland Column 11 lines 8 – 28); and  
the second device is electronic (Southerland Column 11 lines 8 – 28).

**12.** Claim 15 is rejected as applied above in rejecting Claim 14. Furthermore, Sutherland discloses that the cord device is comprised of an electrical cord (Southerland Column 11 lines 8 – 28).

**13.** Claim 16 is rejected as applied above in rejecting Claim 14. Furthermore, Sutherland discloses that the cord device is comprised of an optical cord (Southerland Column 11 lines 8 – 28).

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14. Claim 17 is rejected as applied above in rejecting Claim 14. Furthermore, Varadharajan discloses that the cord device is comprised of a radio transmitter (Varadharajan Column 2 line 33 – Column 3 line 4 and Column 5 lines 4 – 16).

15. Claim 20 is rejected as applied above in rejecting Claim 19. Furthermore, Sutherland discloses that the enclosure is adapted so that the first and second devices can be simultaneously placed into the enclosure and the enclosure can be sealed (Southerland Column 11 lines 8 – 28).

16. Claim 21 is rejected as applied above in rejecting Claim 14. Furthermore, Varadharajan discloses that the first and second devices exchange the key in a wireless manner (Varadharajan Column 2 lines 59 – 65).

17. Claims 4 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Southerland (U.S. Patent Number 6,292,898, hereafter "Southerland") in view of Varadharajan et al. (U.S. Patent Number 5,887,063, hereafter "Varadharajan"). further in view Reidinger et al. (U.S. Patent Number 4,915,222, hereafter "Reidinger").

18. Claim 4 is rejected as applied above in rejecting Claim 1. Furthermore, Southerland and Varadharajan disclose first and second device transmit and receive information to and from each other in a sealed enclosure (Southerland Column 11 lines 8 – 28 and Varadharajan Column 2 line 33 – Column 3 line 4 and Column 5 lines 4 –

16). Southerland and Varadharajan, even when taken together, do not explicitly disclose the enclosure is a plastic bag coated wherein the filtering material of the enclosure prevents electromagnetic radiation of a particular bandwidth from escaping from the enclosure. However, Reidinger discloses a protective enclosure that will be sealed, which provides electromagnetic protection wherein the enclosure is a plastic bag coated with a filtering material wherein the filtering material of the enclosure prevents electromagnetic radiation of a particular bandwidth from escaping from the enclosure (Reidinger Column 3 lines 9 – 15 and Column 5 line 57 – Column 6 line 20).

**19.** Motivation to combine the invention of Southerland and Varadharajan with Reidinger's teachings comes from the need for securing transactions sent between the first and the second device by providing the enclosure made out of a plastic bag and providing protection from electromagnetic radiation. Southerland provide a discussion for the need of such alternatives but silent as to the specific details of the plastic enclosure; see Southerland Column 7 line 57 – Column 8 line 39). It would have been obvious to one having ordinary skill in the art at the time the invention to combine Southerland and Varadharajan with Reidinger because security is needed for the key exchange of Varadharajan and because Southerland provides details of first and second device in an enclosure to interconnect two devices while Reidinger provides protection from electromagnetic radiation and secure environment, thus preventing the intruder from gaining access to the information while the two devices are transmitting data and exchanging keys.

**20.** Claim 6 is rejected as applied above in rejecting Claim 1. Furthermore, Southerland and Varadharajan disclose first and second device transmit and receive information to and from each other in a sealed enclosure (Southerland Column 11 lines 8 – 28 and Varadharajan Column 2 line 33 – Column 3 line 4) and the enclosure is a container having sides comprised of a filtering material (Southerland Column 7 line 43 – Column 8 line 19 and Column 11 lines 8 – 28), Southerland and Varadharajan, even when taken together, do not explicitly disclose that the filtering material of the enclosure prevents electromagnetic radiation of a particular bandwidth from escaping from the enclosure. However, Reidinger discloses the enclosure is a container having sides comprised of a filtering material wherein the filtering material of the enclosure prevents electromagnetic radiation of a particular bandwidth from escaping from the enclosure (Reidinger Column 3 lines 9 – 15 and Column 5 line 57 – Column 6 line 20).

**21.** Motivation to combine the invention of Southerland and Varadharajan with Reidinger's teachings comes from the need for securing transactions sent between the first and the second device by providing the enclosure protection from electromagnetic radiation. Southerland provide a discussion for the need of such alternatives but silent as to the specific details of the enclosure made out of plastic; see Southerland Column 7 line 57 – Column 8 line 39). It would have been obvious to one having ordinary skill in the art at the time the invention to combine Southerland and Varadharajan with Reidinger because security is needed for the key exchange of Varadharajan and because Southerland provides details of first and second device in an enclosure to

interconnect two devices while Reidinger provides protection from electromagnetic radiation and secure environment, thus preventing the electromagnetic radiation of a particular bandwidth from escaping from the enclosure while the two devices are transmitting data and exchanging keys.

**22.** Claim 10 is rejected as applied above in rejecting Claim 1. Furthermore, Southerland and Varadharajan disclose first and second device transmit and receive information to and from each other in a sealed enclosure (Southerland Column 11 lines 8 – 28 and Varadharajan Column 2 line 33 – Column 3 line 4 and Column 5 lines 4 – 16) and the enclosure is a container having sides comprised of a filtering material (Southerland Column 7 line 43 – Column 8 line 19 and Column 11 lines 8 – 28), Southerland and Varadharajan, even when taken together, do not explicitly disclose that the enclosure is comprised of a first and a second compartment; wherein the first and second compartment are separated by a separation device; and wherein the method further comprises placing the first device in the first compartment and the second device in the second compartment. However, Reidinger discloses that the enclosure is comprised of a first and a second compartment; wherein the first and second compartment are separated by a separation device; and wherein the method further comprises placing the first device in the first compartment and the second device in the second compartment (Reidinger Column 3 lines 9 – 15 and Column 5 line 57 – Column 6 line 20).

**23.** Motivation to combine the invention of Southerland and Varadharajan with Reidinger's teachings comes from the need for providing a separate compartment for the first and second device. Southerland provide a discussion for the need of such alternatives but silent as to the specific details of the separating the devices; see Southerland Column 7 line 57 – Column 8 line 39). It would have been obvious to one having ordinary skill in the art at the time the invention to combine Southerland and Varadharajan with Reidinger because security is needed for the key exchange of Varadharajan and because Southerland provides details of first and second device in an enclosure to interconnect two devices while Reidinger provides first and second compartment in a secure environment, thus preventing the intruder from gaining access to the information while the two devices are transmitting data and exchanging keys.

**24.** Claim 5 is rejected as applied above in rejecting Claim 4. Furthermore, Reidinger discloses a protective container with two devices that will be sealed, which provides electromagnetic protection, wherein the filtering material is comprised of metal (Reidinger Column 1 line 49 – Column 2 line 20).

**25.** Claim 7 is rejected as applied above in rejecting Claim 6. Furthermore, Reidinger discloses a protective container with two devices that will be sealed, which provides electromagnetic protection, wherein the filtering material is comprised of metal (Reidinger Column 1 line 49 – Column 2 line 20).

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**26.** Claim 8 is rejected as applied above in rejecting Claim 6. Furthermore, Reidinger discloses that the enclosure is comprised of transparent material (glass) and the filtering material is attached to the transparent material (glass) (Reidinger Column 2 line 53 – Column 3 line 28).

**27.** Claim 9 is rejected as applied above in rejecting Claim 6. Furthermore, Reidinger discloses the enclosure is comprised of plastic and the filtering material is attached to the plastic (Reidinger Column 3 lines 9 – 15 and Column 5 line 57 – Column 6 line 20).

**28.** Claim 11 is rejected as applied above in rejecting Claim 10. Furthermore, Reidinger discloses that the separation device when closed prevents the first device from communicating with the second device (Reidinger Column 3 lines 9 – 15 and Column 5 line 57 – Column 6 line 20), and Southerland and Varadharajan when together, discloses that the separation device when opened allows the first device to communicate with the second device (Southerland Column 11 lines 8 – 28 and Varadharajan Column 2 line 33 – Column 3 line 4 and Column 5 lines 4 – 16).

**29.** Claim 12 is rejected as applied above in rejecting Claim 11. Furthermore, Reidinger discloses that the separation device is composed of a door which can be opened after the enclosure is sealed (Reidinger Column 4 lines 11 – 51 and Column 4 line 67).

30. Claim 13 is rejected as applied above in rejecting Claim 12. Furthermore, Reidinger discloses that the enclosure is a plastic bag coated with a filtering material wherein the filtering material of the enclosure prevents electromagnetic radiation of a particular bandwidth from escaping from the enclosure (Reidinger Column 3 lines 9 – 15 and Column 5 line 57 – Column 6 line 20).

31. Claims 18, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Varadharajan et al. (U.S. Patent Number 5,887,063, hereafter “Varadharajan”) in view Lemilainen et al. (U.S. Patent Number 6,766,160, hereafter “Lemilainen”).

32. Regarding Claim 22, Varadharajan discloses  
a transmitter (Varadharajan Column 4 line1 – 34);  
a port for physically and electronically connecting the portable device to a first device (Varadharajan Column 4 line1 – 34);  
wherein in a first mode the Bluetooth transmitter of the portable device locates a second device and performs a key exchange with the second device via a wireless channel (Varadharajan Column 4 line1 – 34 and Column 5 lines 4 – 16);  
and wherein in a second mode the port of the portable device is physically and electronically connected to a first device so that the portable device can communicate with the first device; and wherein the portable device communicates a key to the first device obtained from the key exchange with the second device (Varadharajan Column 4 line1 – 34 and Column 5 lines). Varadharajan does not explicitly disclose that the



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transmitter is a Bluetooth transmitter. However, Lemilainen discloses a bluetooth-based communication wherein the Bluetooth transmitter of the portable device exchanges a key with the second device via a wireless channel (Lemilainen Column 7 lines 55 – 67 and Column 8 lines 36 – 55).

**33.** Motivation to combine the invention of Varadharajan with Lemilainen's teachings comes from the need for providing agreement (port) at a physical level and electronically connecting to another device without the need for any action from a third party (user). Varadharajan provides a discussion for transmitting data between two devices with I.R. communication link and providing an I.R. transmitter to either to communicate with a device via an I.R. link or via a modem link as well as other sensors which signals the presence of another device, but silent as to the specific details of the Bluetooth transmitter; see Varadharajan Column 4 lines 23 – 61 and Column 5 lines 4 – 27. It would have been obvious to one having ordinary skill in the art at the time the invention to combine Varadharajan with Lemilainen because Bluetooth is wireless, inexpensive and does not require any user's input.

**33.** Claim 18 is rejected as applied above in rejecting Claim 14. Furthermore, Varadharajan discloses that the cord device is comprised of a radio transmitter (Varadharajan Column 2 line 33 – Column 3 line 4 and Column 5 lines 4 – 16). Varadharajan does not explicitly disclose that the transmitter is a Bluetooth transmitter. However, Lemilainen discloses a bluetooth-based communication wherein the Bluetooth

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transmitter of the portable device exchanges a key with the second device via a wireless channel (Lemilainen Column 7 lines 55 – 67 and Column 8 lines 36 – 55).

**34.** Motivation to combine the invention of Varadharajan with Lemilainen's teachings comes from the need for providing agreement (port) at a physical level and electronically connecting to another device without the need for any action from a third party (user). Varadharajan provide a discussion for transmitting data between two devices with I.R. communication link and providing an I.R. transmitter to either to communicate with a device via an I.R. link or via a modem link as well as other sensors which signals the presence of another device, but silent as to the specific details of the Bluetooth transmitter; see Varadharajan Column 4 lines 23 – 61 and Column 5 lines 4 – 27. It would have been obvious to one having ordinary skill in the art at the time the invention to combine Varadharajan with Lemilainen because Bluetooth is wireless, inexpensive and does not require any user's input.

**35.** Claim 24 is rejected as applied above in rejecting Claim 22. Furthermore, Varadharajan discloses that the first device is a disc drive which can be electrically connected to the portable device (Varadharajan Column 2 line 59 - Column 3 line 9) and Lemilainen discloses that the portable device is in the shape of a floppy disc which incorporates a Bluetooth transmitter (Lemilainen Column 6 lines 49 – 66).

***Conclusion***

**36.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on Tuesday – Thursday 8:00a.m. To 3:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy  
March 30, 2005.

  
AYAZ SHEIKH  
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